REMARKS

Claims 2, 3, 5, 6, 8-10, 12, and 46-49 are currently pending within this application. No Claims have been added, amended, or canceled.

The Office has retained its rejection of Claims 2-3, 5-6, 8-10, 12 and 46-49 under 35 U.S.C. §103(a) as being unpatentable over Wiesel in view of Subelka et al. and further in view of Cohen. As before, Applicant strongly disagrees with the Office's position and believes its rejection posited thereby is untenable. The combination of references is improper for the simple reason that a whitening agent for teeth (or, as a common dental agent, as described by Wiesel) is not analogous to a dental restorative agent nor a tooth etchant. Wiesel is clear that his disclosure is directed to providing treatments for cosmetic purposes, with alternative possibilities for treatments utilizing his system to those that provide actual benefits to an entire tooth (hence the necessity of supplying a full coverage to the target tooth or teeth with protection to the gums as well). The Subelka et al. reference is solely directed to a restorative material of a specific type in order to fill in specific areas of a tooth cavity or to replace missing portions of a target tooth. As well, Cohen specifies that his disclosure concerns solely a new manner of applying a tooth etchant to specific areas of target teeth (so as not to, for instance, permit unwanted phosphoric acid to contact gum tissues during treatment). It is unclear from a review of these three disparate references how the ordinarily skilled artisan would actually view these in tandem at all, particularly for the purpose of applying a dental restorative to a tooth surface in a manner to not only allow for proper surface application, but, possibly, for proper radiation exposure and manipulation without contacting any other tooth surfaces or unwanted areas of the target tooth, not to mention to come into contact with the needed spatula during application. There is no

indication, other than these three references pertain to tooth surface treatments as broad concepts, why the combination of such teachings would be of any concern to the ordinarily skilled artisan. Again, a tooth whitener (or desensitizing agent) is not analogous to a tooth restorative, nor to a tooth etchant (which is present, as per Cohen's teachings). There must be some rationale for the ordinarily skilled artisan to view these together for a proper combination to be made. In re Oetiker, 977 F.2d 1443, 1447 (CAFC, 1992). Without any such reason for the ordinarily skilled artisan to look to a tooth restorative material (tooth filling composition) as a means to improve upon or modify a tooth whitening or desensitizing or medicament formulation, let alone to look in addition to a tooth etchant for the purpose of increasing tooth surface areas for better brace mounting strength, there is simply no reason to view any of these references in combination, not to mention all three as the Offices avers is proper, without practicing improper hindsight reconstruction of Applicant's own teachings. For that reason alone, this basis of rejection should be withdrawn.

However, even if such a combination were actually considered proper, the Office fails to provide a proper teaching that meets all of the necessary claim limitations. A combined composite of all three references would provide a possibly T-shaped implement (as "suggested by Cohen, although it would not cover an entire tooth in accordance with Cohen's teachings) which includes a tooth restorative (in place of Wiesel's whitening agent) that is covered in total by a thin flexible core of medical grade silicone, medical grade acrylic, or cellulose products. To the contrary, Applicant's broadest claim reads, as follows:

"A tooth restoration procedure kit including a unit dose of a curable dental restorative

composite, the composite dose disposed on a carrier for spatuling on a tooth intermediate the tooth and carrier, comprising:

a generally "T" shaped transparent, high tensile strength polyester carrier film having a delivery side and a spatuling side, the generally horizontal portion of said "T" shape forming embrasure tabs extending laterally outwardly of the center portion of said "T" shape, and the generally vertical portion of said "T" shape forming an incisal tab extending downwardly of the center portion of said "T" shape; and

a unit dose of curable dental restorative composite disposed on the delivery side of said carrier film, centrally located on the center portion and centrally in respect of said embrasure tabs and incisal tab;

whereby, when said composite unit dose is disposed directly on said tooth, and said embrasure tabs are disposed about the embrasures of the tooth and said incisal tab is disposed about the incisal of the tooth, the dental composite may be spatuled on the tooth through said carrier film."

Noticeably lacking from this combination of references are, at least, the "high tensile strength polyester carrier film", the disposition of a dental restorative on the delivery side of that film (and thus the ability to apply the restorative directly to a subject tooth from the polyester film), and the disposition, definitively, of the film about the tooth embrasures and incisal (and thus the need for an appropriately sized T-shaped film, as shown within Applicant's preferred embodiments and drawings, for instance). The Office states that an Applicant may not attack a combination of references by only attacking one single reference. That is understood; however, in order to make any proper *prima facie* obviousness rejection over patent claims with a combination of references, the Office has to show that the components of the claimed invention are actually present within the combination. Applicant thus must have the ability to show that the combination lacks such teachings that are actually present within his claimed invention. The only way to do that is show that none of the references shows the required elements of his claimed invention.

To that end, it is evident that none of the cited prior art documents teaches the limitations

in total of the currently claimed invention. Subelka et al. are limited in teaching a tooth restorative composition (the only similarity between that patent and the pending claims). There is nothing further provided by this reference that is of concern within the claimed invention. Cohen, likewise, is limited in his contribution to this potential combination of references with a possible T-shaped tooth application delivery implement. Cohen clearly shows that his T-shaped (or, more preferably, H-shaped) implements do not cover an entire tooth, but are disposed in such a way as to permit proper selective placement of his implement, with an etchant material included thereon, on a tooth surface to permit concentrated application of the etchant to a specific tooth area or region. There is nothing within this reference that discusses the importance of embrasure and/or incisal configurations. Applicant thus respectfully submits that since Subelka et al. is silent as to any delivery implement on a tooth, and Wiesel does not suggest a targeted tooth region for application of his tooth treatment composite, and certainly expresses no need for a T-shaped configuration for his composite at all, the only type of T-shaped implement that could be present would be one that does not cover an entire tooth (as this is Cohen's specific, limited teaching), or one that is not arranged for embrasure and incisal coverage (as is now required of the presently claimed invention).

Of greater importance, however, is the lack of the requirements as it concerns the required polyester film of the currently claimed invention. As Claim 46 (above) shows, the polyester film must be high tensile strength and must have a delivery side on which a tooth restorative is disposed and a spatuling side. The tooth restorative is then applied directly to a tooth, thus requiring that the restorative be in contact, simultaneously, with the tooth surface and the high tensile strength film. Where, exactly, is this necessary limitation present within the

proffered combination of references pieced together by the Office? The only possible component of this "combination" has to be the core material cited within the Wiesel patent. The Office stretches the teachings of Wiesel, unfortunately, to make the argument that this core material meets the limitation of a polyester film, particularly a high tensile strength polyester film. Citing the oft misapplied decision of Application of Leshin, 277 F.2d 197, 199 (CCPA 1960), the Office merely states that "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice" and has determined that high tensile strength polyester film is the same, for these purposes, as Wiesel's medical grade silicone, acrylics, and cellulose products. Such would, possibly, be true, but for the Office's misunderstanding of Wiesel's actual teachings. Patentee states, specifically, that his core material "is preferably made of a biodegradable material or of a similar material that can be washed or brushed away" (col. 3, lines 13-16, lines 66-67). To the contrary, Applicant's strong, pliant polyester film (such as, for instance, MYLAR) is not biodegradable, and, when applied to the tooth via the restorative, the film must withstand the spatuling and like maneuvers that would easily remove a material that would be brushed or washed away from the subject tooth surface. It is evident that there has been nothing presented within this "combination" of references (of which, again, Applicant does not agree is proper, but is based upon improper hindsight reconstruction of Applicant's own teachings) that meets this specific limitation. The closest the Office can get is the backing of Wiesel which covers this core material. However, the configuration of Wiesel, and thus the configuration of the "combined" teachings of these references, fails to provide a tooth restorative in contact with a backing, rather than a core material. Wiesel requires a core to protect the user's gums from the

whitening agent present within the central composite component; there is no reason to remove that core material. Without the same limitations as now claimed, the Office has failed to meet the requisite level of a *prima facie* obviousness rejection as the "invention as a whole" is lacking. Jones v. Hardy, 727 F.2d 1524, 1530 (CAFC 1984). Reconsideration and withdrawal of this improper obviousness rejection are therefore earnestly solicited.

CONCLUSION

In view of the remarks supplied above, it is respectfully submitted that the present claims of this application are now in condition for allowance and that this case be passed on to issue.

Respectfully submitted,

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